

REMARKS

This is in response to the Office Action that was mailed on January 7, 2005. Claim 1 is amended based upon such disclosure as that appearing in lines 10-15 on page 9 of the specification. Claim 4 is amended to depend solely from claim 1. New claims 5 and 6 are added, based upon original claim 4 but depending solely from claim 2 and 3, respectively. New claim 7 is added, based upon disclosure in the paragraph bridging pages 9-10. New claims 8-10 are added, based respectively upon Examples 1-3. No new matter is introduced by this Amendment. Claims 1-10 are pending in the application.

Objection was raised to claim 4 as being an improper multiple dependent claim. Originally, claim 4 depended from any one of claims 1 to 3. Claim 4 has now been amended to depend solely from claim 1. New claims 5 and 6 have been added, corresponding to claim 4 but depending solely from claims 2 and 3, respectively. It is respectfully submitted that this obviates the objection to claim 4. The Examiner is therefore requested to reverse the withdrawal from consideration of claim 4 and to consider claims 4-6 on their merits along with claims 1-3 from which they depend and along with claims 7-10 which depend from claim 1.

Claims 1-3 were rejected under 35 U.S.C. §102(b) as being anticipated by US 5,643,986 (Ishikawa '986). It is respectfully submitted that the rejection does not apply to claims 1-10 in their present form.

In the polyimide described in Ishikawa '986, the tetravalent residue R¹ is derived exclusively from **aromatic** tetracarboxylic acids. See e.g. column 14, lines 56-57, and claim 1 of the reference. In contrast, the tetravalent organic group in the present polyimide, is derived from **aliphatic** or **alicyclic** tetracarboxylic anhydrides. The presently claimed polyimidesilicone resins may also involve small amounts of aromatic tetracarboxylic anhydrides, but the amounts thereof are strictly limited such that the resulting polyimide is colorless ("with said aromatic tetracarboxylic dianhydrides being in such an amount that they do not cause discoloration of the polyimidesilicone resin").

The Examiner alleges that the polyimide resin described in Ishikawa '986 is inherently colorless. Applicant respectfully disagrees. A polyimide derived exclusively from aromatic tetracarboxylic acid generally has color, because - as is well known to those skilled in the art - conjugation of carbonyl groups and aromatic rings extend UV absorption into the visible region.

Manifestly, the invention defined by claims 1-6 in their present form is novel with respect to Ishikawa '986.


Although no obviousness rejection has been made, Applicants point out that Ishikawa '986 patent fails to provide any motivation for a person with ordinary skill in the art to substitute aliphatic or alicyclic tetracarboxylic acids for aromatic tetracarboxylic acids. Likewise, Ishikawa '986 fails to motivate limitation of the amount of aromatic tetracarboxylic acids in polyimidesilicone resins. The Ishikawa '986 disclosure teaches that its polyimide compositions are heat resistant at a temperature as high as 260°C. Column 9, line 4. Faced with the Ishikawa '986 disclosure, a person with ordinary skill in the art would not partly or fully replace the aromatic tetravalent residues of the polyimide with aliphatic or alicyclic ones, which are known to be less heat resistant. Thus, Ishikawa '986 fails to suggest the present polyimide resin at all, and therefore the present invention is not obvious over Ishikawa '986.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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